

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDENORI HIRAOKA and AKIHIKO HAMADA

Appeal No. 95-4242
Application 08/063,290¹

ON BRIEF

Before KIMLIN, WARREN and LIEBERMAN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-18, all the claims in the present application. Claim 1 is illustrative:

1. A rubber composition suitable for use in grips of articles, which consists
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¹ Application for patent filed May 19, 1993.

essentially of (1) a rubber component containing an ethylene-propylene-diene rubber, and (2) 5 to 100 parts by weight of polyisobutylene having a viscosity average molecular weight of 6,000 to 50,000 per 100 parts by weight of said rubber component.

The examiner relies upon the following reference as evidence of obviousness:

Briddell et al. (Briddell)	5,242,747	Sep. 07, 1993
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Appellants' claimed invention is directed to a rubber composition and a grip made from such a rubber composition. The composition consists essentially of ethylene-propylene-diene rubber and a polyisobutylene having a viscosity average molecular weight of 6,000 to 50,000. The rubber composition finds utility in making grips of golf clubs, tennis rackets and the like. According to appellants, grips made from the claimed rubber composition are not slippery, have a good feeling of touch, and exhibit a good cushioning action.

Appealed claims 1-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Briddell.

Upon careful consideration of the opposing arguments presented on appeal, we agree with appellants that the disclosure of Briddell fails to establish a *prima facie* case of obviousness for the claimed subject matter. Accordingly, we will not sustain the

examiner's rejection for essentially those reasons expressed in appellants' principal and

reply briefs on appeal. We offer the following for emphasis only.

Although Briddell discloses a rubber composition containing an ethylene-propylene-diene rubber and a polyisobutylene, the composition of Briddell also necessarily contains a tackifier which allows the reference rubber composition to serve as an adhesive for providing water-tight joints in single-ply roofing membranes. Since it is well settled that appellants' claim language "consists essentially of" excludes all components that materially affect the basic nature of the claimed composition, we fully concur with appellants that the appealed claims exclude the tackifier of Briddell. Manifestly, the inclusion of Briddell's tackifier in the claimed composition would result in a composition that is not suitable for use in grips of articles. Since the examiner has not explained why it would have been obvious for one of ordinary skill in the art to remove the tackifier of Briddell, and such is not apparent to us, there is no factual basis for concluding that the claimed rubber composition and grip would have been obvious to one of ordinary skill in the art in view of the rubber composition of Briddell.

Based on the foregoing, the examiner's decision rejecting the appealed claims is

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reversed.

REVERSED

EDWARD C. KIMLIN
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

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